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Patent and Trademark Office
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MAILED

07-24-688A

December 30, 1991

In re Application of
Deuel et al.
Serial No. 07/542,232
Filed: June 21, 1990
For: Heparin-Binding Growth Factor

OFFICE OF THE DIRECTOR DECISION
GROUP 180 ON *#9*
PETITION

This is a decision on the petition, filed July 18, 1991, under 37 CFR 1.144 requesting review and withdrawal of the restriction requirement.

The petition is DENIED.

The petition takes the position that the DNA of claims 4-7 is not patentably distinct from the proteins of claims 1-3 since the inventions are not independent and distinct as specified by MPEP Section 803 as the conclusions advanced by Examiner are not supported by valid or sufficient reasons, and no serious burden exists as to examination in one application.

These arguments are not found persuasive. The Examiner should have indicated that the DNA and the protein are patentably distinct chemical products even though they are related in the context that the claimed DNA codes for the claimed polypeptides. That these products are patentably distinct is clearly seen from the following factors: the claimed DNA is not necessary to the preparation of the claimed polypeptides; the claimed polypeptides may be made by isolating naturally-occurring proteins; and the claimed DNA may also be used as a molecular weight marker in an electrophoretic separation process. Petitioner should note in this regard that claims 1-3 fairly encompass more DNA sequences than those claimed.

Furthermore, the burden to the Office of searching these two patentably distinct inventions together is seen from the fact that the classified and literature search required for the claimed polypeptides is different from that required for the claimed DNA.

For these reasons, the restriction requirement is deemed correct.

Petitioner is reminded that the instant petition did not require a fee and a refund may be obtained from the Office of Finance.

Edward E. Kubasiewicz
Director, Group 180

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